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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1966

No. 432

GEORGE O. GRAVES, d/b/a MICHIANA MILLS,
Petitioner,

vs.

KELL-DOT INDUSTRIES, INC., EDWIN F. KELLY, MANLEY, INC.,
Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT

Petitioner, the plaintiff-appellee below, respectfully prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Eighth Circuit entered in the above entitled action on May 18, 1966.

OPINIONS BELOW

The opinion of the United States District Court for the Western District of Missouri, including its Finding of Fact and Conclusions of Law, is reported at 229 Fed. Supp. 143 and is printed in Appendix A infra to this Petition. The United States Court of Appeals for the Eighth Circuit reversed the foregoing decision of the U. S. District Court, and its decision is printed in Appendix B to this Petition.

JURISDICTION

The judgment of the Court of Appeals was entered on May 18, 1966. The jurisdiction of the Court is invoked under 28 U.S.C. 1254.

QUESTIONS PRESENTED

The questions presented, on which the Court of Appeals in reversing the decision of the District Court erred in matters of law, are, the following:

(1) Whether the claims of a patent form the basis for a determination of validity of the patent over the prior art, i.e. whether the Court can properly and lawfully disregard the *language, meaning* and *intent* of the patent claims, as allowed by the Patent Examiner, in determining whether the patent is invalid over the prior art, and in so doing, hold the patent invalid on the substance of broader claims specifically and finally rejected by the Patent Examiner and not in any way forming a part of the patent granted by the U. S. Patent Office.

(2) Whether the Court of Appeals can disregard the law with respect to the presumption of validity of a patent as explicitly set forth in 35 U.S.C. 282, particularly when the U. S. Patent Office allowed the patent claims and the lower U. S. District Court held the patent valid, over *the same prior art* and *admittedly the best prior art* available.

(3) Whether the Court of Appeals erred in failing to apply the law set forth by the Supreme Court in Graham et al. v. John Deere of Kansas City, 383 U.S. 1, for determining the patentability of an invention over the prior art, and in failing to follow the formula specifically and clearly enunciated in the Graham case for determining obviousness, particularly with reference to the invention defined in the claims of the patent.

STATUTES INVOLVED

The statutes primarily involved in this petition, as a result of the manifest errors in matters of law by the Court of Appeals for the Eighth Circuit in the above entitled case, are Sections 112 and 282, Title 35 of the Patent Act of 1952, and Section 103 of Title 35 is involved with respect to the application of Sections 112 and 282, the relevant portions of each being quoted below:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." (35 U.S.C. 112).

"A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it." (35 U.S.C. 282).

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." (35 U.S.C. 103).

STATEMENT OF THE CASE

The Petitioner brought this suit against the appellants for infringement of U. S. Patent No. 2,842,072, issued on July 8, 1958, to the Petitioner, George O. Graves, d/b/a Michiana Mills (See Certified Transcript of Record: Vol. II, Page X-145).

The subject matter of the patent in suit relates to a machine for producing an extruded and puffed corn product from corn meal and consists generally of a housing having a chamber, a head plate mounted across the end of the chamber and having a plurality of extrusion holes, and a rotatable screw in the chamber for propelling the corn meal to the head plate and through the extrusion holes. The extrusion holes in the head plate are of such size with respect to the effective size of the screw chamber that sufficient pressure and friction are created in the meal during the operation of the machine to increase the temperature of the meal sufficiently to vaporize the moisture and gelatinize the starch in the meal. As the extruded material reaches the atmosphere, it immediately expands or puffs into a light, highly cellular, relatively brittle products, which is known in the trade as "collets" or "corn curls".

A similar product had previously been made on a machine involving a plurality of head plates, no one of which alone would produce a puffed product, and it was universally accepted in the trade *at that time* that two or more head plates were necessary in order to obtain the puffed product. The two head plate machine, which was the only prior machine capable of producing this product, was disclosed in and covered by U. S. Patent No. 2,705,927 (Rec. P. X-153) and this prior patent was considered by the U. S. Patent Office when the claims of the present patent were allowed.

This prior machine had the serious fault of causing the meal material to "freeze" and back up in the screw chamber, preventing further operation of the machine until it was cleaned and restarted. This necessitated taking the machine apart, removing the solidified and burnt material, reassembling the machine, heating the head plate to the required temperature and starting the machine with a specially prepared meal mix. As the Record before the lower Courts clearly showed, this occurred a number of times during a single day with the prior dual head plate machines, thus greatly decreasng the efficiency of the overall operation and resulting in much down-time of the machines. Despite the recognized serious drawbacks, the machines of the aforementioned prior Patent No. 2,705,927 were used for nearly eight (8) years without any significant changes in the head plates, since the experts in the trade accepted the use of two head plates on the machine as unavoidable and necessary to the operation of producing satisfactory collets or corn curls. The Petitioner's improvement of the patent involved in this suit was in direct conflict with the belief and practice in the collet manufacturing trade.

In order to overcome the difficulties, the Petitioner, through experimentation over a number of months, discovered the product could be produced by the use of a specially designed, single and much simpler head plate construction. The use of this single head plate gave the surprising and unobvious result of eliminating or minimizing the freezing and backing up of the meal in the machine and the ultimate result of doubling the daily output of the machines. The Record clearly shows that this unexpected increase in production was not due merely to the convenience and economy of a single head plate over the prior two head plate construction, but was due princi-

pally to the elimination of the freezing of the product in the machine, thereby permitting the machine to run consistently and continually over long periods of time without interruption, a condition not obtainable with the prior machines.

The simplified operation and increased production made it possible and practical for the first time to place the collet machine in the hands of the inexperienced operator in the field, since care, service and control during operation were greatly reduced. Consequently, promptly after making the invention, the Petitioner, Mr. Graves, placed the present machine in commercial operation and these machines have been in commercial operation since the first part of 1956. In addition to using the machines for the production of commercial product, the Petitioner has, since as early as the first part of 1957, placed them in the hands of a large number of food processors under a very successful licensing and sales program.

The Appellate Court erroneously stated that the impetus which spurred the Petitioner on to develop the machine of the present Patent No. 2,842,072 was to avoid infringement of U. S. Patent No. 2,705,927. The Record shows, to the contrary, that the Petitioner had previously developed a machine with a single plate, two stage construction which avoided the prior patents. This intervening machine is covered by the Petitioner's Patent No. 2,853,027 which issued on an application filed before the application involved in this matter. While the reason for carrying on the development is not important, it is clear from the record that the present machine was developed and designed to overcome the serious disadvantages of the machine of the prior Patent No. 2,705,927. The Appel-

late Court merely considered the obvious advantage of a single head plate structure versus a dual head plate structure with respect to cleaning, completely ignoring the much more important result of elimination of "freezing" and back up of the product in the machine during operation, which necessitated the cleaning operation. This is relevant to the questions raised in this Petition in that the Appellate Court, while stating that it was reversing the District Court's decision and holding the patent invalid in view of the Supreme Court's Graham decision, failed to apply the formula clearly and unequivocally set forth in the Graham decision involving the language of the patent claims, for determining obviousness or unobviousness of the invention covered by the claims.

Further, it is significant that during the prosecution in the U. S. Patent Office of the patent in this suit, the Patent Examiner, after carefully examining the application, first refused to allow claims directed merely to a single head plate, but allowed the patent claims when the structural requirements essential to the production of collets or corn curls by a single head plate were specifically set forth in later presented claims. The U. S. District Court held those claims, as allowed by the U. S. Patent Office, valid and infringed. However, *the Court of Appeals, in arriving at its decision, disregarded the language which the Patent Examiner stated was essential for the allowance of the claims, and instead, interpreted the claims in the same manner as the claims previously and finally rejected by the Examiner.*

The District Court in its decision had held that the accused device infringed all five claims, Claims 1 through 4 by equivalency, and Claim 5 directly, and the Court of Appeals in its decision, with which this Petition is concerned, stated that "The accused device is essentially a

copy of the patent in suit with only slight expected variations." The Court of Appeals, nevertheless, held the patent invalid, relying solely on the same best prior art considered by the U. S. Patent Office in allowing the claims and by the U. S. District Court in arriving at its decision of validity and infringement of the Petitioner's patent.

REASONS FOR GRANTING WRIT

1. The Decision of the Court of Appeals holding the patent invalid was not based on the claims of the patent as determined from the language, meaning and intent, but rather was based on the subject matter as defined in the claims rejected and refused to the Petitioner by the Patent Examiner.

The Court of Appeals misconstrued and misapplied the law of the recent decisions on patents by this Court with respect to the part claims of the patent play in determining validity, notwithstanding the fact that the Court of Appeals specifically stated that the Petitioner's patent in suit No. 2,842,072 was invalid in view of the recent teachings of the Supreme Court, the decision of the Court of Appeals stating in part as follows:

> "Based primarily on the recent teachings of the Supreme Court in Graham v. John Deere Co., . . . U.S. . . . (1966), we conclude that the patent is *invalid* and, therefore, *reverse*."

The Supreme Court made it amply clear in the Graham Case (383 U.S. 1), however, that the substance of the claims as allowed by the Patent Office is an essential consideration in determining validity, as shown by the following paragraph therefrom:

> "While the ultimate question of patent validity is one of law, A. & P. Tea Co. v. Supermarket Corp., supra, at 155, 87 USPQ at 307, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; *differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.* Against this background, the obviousness or unobviousness of the subject matter is determined." (383 U.S. 1).

The importance of the subject matter defined in the patent claim was also recognized by the Supreme Court in the related *Calmar, Inc.* v. *Cook Chemical Co.*, 383 U.S. 1, as an essential element in determining validity, the Court stating in part as follows:

> "It is, of course, *well-settled that an invention is construed not only in the light of the claims,* but also with reference to the file wrapper or prosecution history in the Patent Office. Hogg v. Emerson, 11 How. 587 (1850); Crawford v. Heysinger, 123 U.S. 580 (1887). *Claims as allowed must be read and interpreted with reference to rejected ones and to the state of the prior art; and claims that have been narrowed in order to obtain the issuance of a patent by distinguishing the prior art cannot be sustained to cover that which was previously by limitation eliminated from the patent.* Powers-Kennedy Co. v. Concrete Co., 282 U.S. 175, 185-186, 7 USPQ 122, 126 (1930). Schriber Co. v. Cleveland Trust Co., 311 U.S. 211, 220-221, 47 USPQ 345, 348-349 (1940)." (383 U.S. 1).

Likewise in *United States* v. *Adams*, 388 U.S. 39, the Supreme Court gave fundamental consideration to the language and subject matter of the claims in holding the patent valid, as seen from the following:

> "While the claims of a patent limit the invention, and specifications cannot be utilized to expand the patent monopoly, Burns v. Meyer, 100 U.S. 671, 672 (1879) McCarty v. Lehigh Valley R. Co., 160 U.S. 110, 116 (1895), *it is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention.* Seymour v. Osborne, 11 Wall. 516, 547 (1870); Schriber-Schroth Co. v. Cleveland Trust Co., 311 U.S. 211, 47 USPQ 345 (1940); Schering Corp. v. Gilber, 153 F.2d 428 (1926). Taken together with the stated object of disclosing a water-activated cell, the lack of reference to any electrolyte in Claims 1 and 10 indicates that water alone could be used. Furthermore, of the 11 *claims* in issue, three of the narrower ones include references to specific electrolyte solutions comprising water and certain salts. The obvious implication from the absence of any mention of an electrolyte—a necessary element in any battery—in the other eight *claims* reinforces this conclusion." (383 U.S. 39).

In addition to the importance given the patent claim by the Supreme Court, the *Patent Statute, 35 U.S.C. 112,* specifically states that the specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. The Supreme Court in the Graham, Cook, and Adams cases not only followed the well-established case and statutory law with respect to the subject matter set forth in the patent claims, but also set forth in the Graham Case explicitly how the claims should be used in determining validity over the prior art, as seen from the foregoing excerpt.

Notwithstanding the well-established law on the matter of patent claims, in its decision, the Court of Appeals disregarded the *language, meaning* and *intent* of all five (5) claims in the Petitioner's patent and held those claims

invalid strictly *as if they were the same as those rejected by the Patent Examiner and disallowed to the Petitioner by the U. S. Patent Office.* After stating that the Petitioner's patent was being held invalid in view of the Supreme Court's decision in *Graham* v. *John Deere Co.*, the Court proceeded to misinterpret and misapply the law clearly and unequivocally set forth in the Graham decision, the Appellate Court stating as follows with respect to the claims:

> "Plaintiff originally supported his application with eighteen claims. Upon rejection by the patent office, he attempted amendment of some but finally cancelled all of them and submitted, at the suggestion of the examiner, the claims heretofore set out in the margin which are the basis of the examiner's approval and which measure the grant of patent. A number of the rejected claims refer directly to utilization of single head plates but the five constituting the basis of plaintiff's patent do not.
>
> "Nonetheless, plaintiff's patent must be sustained if at all upon the employment of the single head plate. *We assume that stripped of its patentise language, the five claims primarily focus attention to the single head plate and do not understand the patent examiner's rejection of more specific claims for this element and final acquiescence when more obscure language was employed.* The examiner must have been persuaded by the configuration of the single head plate, but it is admitted that the older machines prebaked the material and there is no novelty in the shape or configuration of the element."

A cursory comparison of an application claim drawn principally to a single head plate with a claim of the patent clearly shows that the claim of the patent was much more limited than the rejected application claim and that the phrases defining those limitations were necessary and were

incorporated in the claims granted in the patent not merely as "patentise language" but to distinguish over the prior art and to render them allowable. Rejected Claim 4 of the application to which the Appellate Court referred in its opinion reads as follows:

> "4. A machine for producing collets from cereal mixture, comprising a hopper for cereal, a housing having a bore therein adapted to receive cereal from said hopper, a one-piece, one-stage plate secured to said housing across said bore and having a plurality of extrusion holes therethrough and communicating with said bore and disposed in a circle in said plate adjacent the side wall of said bore, said plate being a solid member across said bore except for said holes, and a means for propelling said cereal mixture to and through the holes in said plate."

Claim 5 of the patent reads as follows:

> "5. In a machine for extruding and puffing cereal meal: a housing having a bore therein, a rotatable member in said bore having a helical ridge on the periphery thereof, an extrusion die plate mounted on said housing across said bore and having a plurality of extrusion holes extending through the plate and communicating directly with the area in said bore occupied by the ridged periphery of said member, each of said holes having an inlet portion tapering inwardly and an elongated portion connected to said tapered portion and extending through the plate to the outside surface thereof, *the total cross sectional area of said elongated portions being sufficiently less than the cross sectional area of said bore occupied by said helical ridge and the length of said elongated portions being sufficiently great to create sufficient friction and pressure to raise the temperature of the meal being fed therethrough to prebake said meal before it is expelled from said holes,* and a knife means intermittently passing the outlet ends of said extrusion holes for cutting the extruded material into sections."

The italicized portion constitutes the "patentise language" added at the Patent Examiner's request to render the claims allowable over the rejected claims, but this portion was disregarded by the Appellate Court in holding the patent invalid, thus treating the claims *rejected* by the Patent Office and those *allowed* by the Patent Office as the same even though a cursory comparison of the two will show the patent claim is much more limited. It should be noted that the portion of the patent claim in italics restricting very substantially the scope of the patent claim from the rejected claim constitutes about one-third (1/3) of the patent claim and cannot properly be disregarded by the Court merely as patentise language.

It is well recognized and appreciated that patent cases are inherently difficult to understand, and construing patent claims is often a most difficult task. However, the Court cannot properly reject or disregard the substance of the patent claims which, because of its limitations in scope defined therein, renders it inherently more difficult to understand, and then in effect substitute therefor a broader claim more easily understood but disallowed by the Patent Office. The difficulty of understanding claims and the subject matter of the prior art is one important reason why substantial weight should be accorded the clear meaning of *Patent Statute, 35 U.S.C. 282, imparting a presumption of validity* to a patent, as will be further discussed hereinafter.

The Appellate Court in disregarding the substance of the patent claims shattered the basic concept of patent claims which have as their sole purpose to define the patentable invention. It was manifestly an error not to give the clear and intended meaning to the complete claims in deciding whether the claims were valid.

The misapplication of the law in the present case will lead only to more confusion in the Courts, as well as a gross injustice to the Petitioner, if the Supreme Court does not correct the error. It is apparent from the decision of the Appellate Court that the clear meaning and substance of the patent claims were never considered by the Court in holding the patent invalid over the prior art.

The Appellate Court obviously failed to apply this succinct and specific requirement set forth by the Supreme Court in the recent *Graham, Calmar* and *Adams* cases (*supra*), and, as a result, the Petitioner's patent has been held invalid by the Appellate Court in view of the prior art, without the primary issue of the patentability of the invention set forth in the claims, having been ascertained.

THE STATUTORY PRESUMPTION OF VALIDITY IGNORED BY THE APPELLATE COURT

2. The Decision of the Court of Appeals, if permitted to stand, will create further and substantial confusion relative to the presumption of validity requirement of 35 U.S.C. 282.

The presumption of validity of the Petitioner's patent as required by 35 U.S.C. 282 was totally ignored by the Appellate Court, notwithstanding the fact that *the same and the best prior art* on which the Court held the patent invalid was carefully considered by both the U. S. Patent Office when the claims were allowed and by the District Court when the claims were held valid and infringed. The foregoing statute reads in part as follows:

> "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it." (35 U.S.C. 282).

This statute has been frequently and variously construed by the District and Appellate Courts, the Courts usually holding that the statutory presumption is substantially weakened where pertinent prior art was not before the Patent Office, *but, as in this case, the presumption is greatly strengthened where the pertinent prior art was considered by the Patent Office when the claims of the patent were allowed.*

Georgia-Pacific Corp. v. *U. S. Plywood Corp.*, (C.A. 2) (258 F.2d 124).

Manville Boiler Co., Inc. v. *Columbia Boiler Co. of Pottstown, Inc.*, (C.A. 4) (269 F.2d 600).

Arnold Pipe Rentals Co., Inc. v. *Engineering Enterprises, Inc.*, (C.A. 5) (350 F.2d 885).

Nasco, Inc. v. *Vision-Wrap, Inc.*, (C.A. 7) (352 F.2d 905).

Neff Instrument Corp. v. *Cohn Electronics, Inc.*, (C.A. 9) (298 F.2d 82).

King-Seeley Thermos Co. v. *Refrigerated Dispensers, Inc. et al.*, (C.A. 10) (354 F.2d 533).

The legal requirement with respect to the statutory presumption, as interpreted by the Court, is set forth in varying degrees from one judicial circuit to another, both relative to art considered and art not considered by the Patent Office. But, in no case other than the present, did the Petitioner find where the Court's decision treated the presumption as a nullity. In the decision by the District Court (Appendix A), from which the appeal was taken, the presumption of validity was acknowledged by the Court stating as follows:

> "It is a natural tendency in dealing with patents to substitute hindsight for foresight and by looking at the status of the invention at present determine that the invention is not invention, but is merely a use which was forecast by the prior art. This, to the Court's mind, is one of the reasons *patents are presumed to be valid*, and why doubts are resolved in favor of invention."

The Appellate Court, however, ignored the presumption of validity even though *no new, better prior art* was available to the Court than to the Patent Office, thus injecting into the field of law an even wider degree of divergence in decisions. In both the Graham and Calmer cases, new prior art of importance was considered in arriving at the decision of patent invalidity. In the present case, however, all of the best prior art was considered by the U. S. Patent Office and the District Court, and this fact was admitted by defendant's own expert witness. A thorough and careful reading of the decision of the Appellate Court fails to reveal any indication whatever that the statutory presumption of validity entered the mind of the Court with respect to the claims in issue in this case.

The Appellate Court merely generalized with respect to the prior art without considering, in any manner, the basic distinctions between the prior art machines and Petitioner's disclosed and/or claimed invention as shown by the following paragraph from the Appellate decision (Appendix B):

> "Plaintiff's motivation to avoid infringement has no bearing on the validity or lack thereof in his machine. What is important is that plaintiff's machine explicitly follows the prior art found in the G & R patent with the sole exception of utilization of a single extrusion head plate. Important also is that the prior art is replete with examples of extrusion ma-

chines using a single head plate. So many examples exist in the prior art that only a representative few were inserted in the record evidence. Examples are Tanzi Patent No. 1,228,495 (1922), machine for making macaroni; Sizer Patent No. 1,402,672 (1922), machine for making food cubes from meal for animals; Sizer Patent No. 1,773,552 (1930), machine for making pellets for poultry food; Schreiber Patent No. 2,583,600 (1952), machine for making food from combinations containing as much as 50% molasses and 50% dry ingredients."

The basic distinctions over the prior art were set forth in the patent claims as identified by the italicized part of the patent claim quoted hereinbefore, but these distinctions were not even admitted to exist by the Appellate Court, when the prior art was alluded to in its decision.

While 35 U.S.C. 282 states that "a patent is presumed to be valid" this statement necessarily is qualified and limited by the subject matter specifically defined in the patent claims. The fundamental error made with respect to this question is that the Appellate Court failed to apply the law set forth in 35 U.S.C. 282 to the patentable invention set forth in the claims as allowed by the Patent Office rather than to the unpatentable and broader concept of merely the use of a single head plate without reference to the structural requirement necessary to produce the desired results. Such a fundamental oversight by the Appellate Court in the application of the law should not be permitted to stand by this Court.

For the Appellate Court to ignore a statute which is so clearly and unquestionably applicable as in this case, is to deny a litigant his fundamental rights under the law. The Petitioner feels that, unless the Supreme Court speaks on this point of law and interprets the statute, setting forth

guide lines which can be followed in future decisions, more confusion among the Courts of the various circuits will unavoidably result.

CONCLUSION

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX A

IN THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF MISSOURI WESTERN DIVISION

GEORGE O. GRAVES, d/b/a Michiana Mills, *Plaintiff*,

vs.

KELL-DOT INDUSTRIES, INC., et al., *Defendants*.

No. 14152-2

Memorandum, Order, Findings of Fact and Conclusions of Law

(Filed May 14, 1964)

This is an action for patent infringement in which jurisdiction is based on §§ 1338(a) and 1400(b), Title 28, United States Code. Plaintiff's amended complaint alleges that his patent #2,842,072, is being infringed both equivalently and actually by defendants' food processing machine.

Plaintiff's patent describes a food processing machine for extruding and puffing cereal meal. The machine consists essentially of a housing with a bore therein, a rotatable member within the bore with a helical ridge on the periphery, a single extrusion die plate with a plurality of extrusion holes therein, each of the holes having a conical inlet connected to a cylindrical or elongate portion

extending through the die plate, an annular flange on the periphery of the die plate with holes therein for securing the die plate to the housing, and a knife intermittently passing the outlet ends of the extrusion holes for cutting the extruded material in sections. The novelty of plaintiff's machine lies primarily in the employment of a single rather than a multiple headplate arrangement, which will prebake the cereal product.

The machine of defendants is substantially the same as that described in plaintiff's patent, with the major deviation from plaintiff's machine being the design and configuration of the extrusion holes contained in the headplate. Where plaintiff's extrusion holes are essentially composed of a tapered inlet portion connected to a cylindrical or elongate portion, defendants' machine utilizes an extrusion hole which is tapered in its entirety. This extrusion hole used by defendants produces a product which to the eye of the Court is identical to that produced by the plaintiff's machine.

Plaintiff contends that defendant's food processing machine infringes claims one through four both directly and equivalently, and infringes claim five directly. Defendant advances the defense that there is no infringement primarily for the reason that the difference in the design of the extrusion holes is a difference at the very point of the novelty of plaintiff's claimed invention.

The background out of which this action arose can be briefly outlined as follows:

In 1948, plaintiff entered business with his brother and Darwin F. Rosebrook in the manufacture of corn meal collets which when salted and coated with cheese are known by various trade names such as "Cheez Stix," "Cheezits," etc. At that time plaintiff and Rosebrook de-

signed a food processing machine for the manufacture of collets. That machine employed a two stage extrusion process using a multiple headplate arrangement, and was the subject of patent number 2,705,927, known as the G & R patent and the Jacks patent. In 1952, a difference arose between plaintiff, his brother, and Rosebrook over the distribution of some royalties, and plaintiff terminated his services with his brother and Rosebrook, took one of the G & R machines, and pursuant to an oral agreement between plaintiff, his brother, and Rosebrook concerning the use of the G & R machine, went into business for himself.

In 1953, plaintiff's brother and Rosebrook were killed in an airplane crash, and thereafter some doubt arose as to plaintiff's right to use the machine covered by the G & R patent. In 1955, plaintiff changed his machine from a two stage dual headplate machine to one employing a two stage single headplate arrangement. In the forepart of 1956, plaintiff again changed his machine, this time to one employing a single stage single headplate, and in March 1956, plaintiff applied for a patent on that machine which was granted in July 1958, and which is the patent here in suit. Machines produced under this patent have been in commercial operation since 1956, and at the present time, plaintiff has some 18 machines placed under leasing agreements.

Prior to 1960, one of the machines covered by the patent in suit here was in operation at Atlanta, Georgia, in the Filler Products Co. plant. Defendant Edwin F. Kelley was a production engineer at the Filler Products plant, and while there observed the machine in operation. Kelley also observed the plaintiff's machine in operation at the Clover Club Food Co. plant in Kaysville, Utah.

In 1960, Kelley participated in the formation of the defendant Kell-Dot company, and in 1961, under an agreement with defendant Manley, Kell-Dot moved into the premises occupied by Manley. The defendants there built and offered for sale a food processing machine which used a two stage dual headplate extrusion system. Upon the production of that machine the defendants were notified by the holders of the G & R patent that the machine constructed by defendants infringed the G & R patent. Defendants then notified the holders of the G & R patent that they intended to manufacture a machine using a single headplate extrusion system, and the G & R patent holders informed defendants of the existence of plaintiff's patent. Defendants proceeded with the construction of machines using a single headplate and have continued to make and use single stage single headplate machines since 1961.

Assuming arguendo that plaintiff's patent is valid, the Court is of the opinion that defendants' machine does not directly infringe plaintiff's claims one through four, but that it does infringe those claims by equivalence. Although the configuration of the extrusion holes of defendants' headplates is different from the shape described in claims one through four, the defendants' machine produces the same product as that of the plaintiff, and produces it in substantially the same manner. Thus, under the test laid down in *Machine Co.* v. *Murphy*, 97 U.S. 120, 125 (1877), and followed in *Graver Mfg. Co.* v. *Linde Co.*, 339 U.S. 605, 608 (1950), that ". . . if two devices do the same work in substantially the same way, and accomplish substantially the same result they are the same, even though they differ in name, form, or shape", it is clear that defendant's machine infringes claims one through four of plaintiff's patent by equivalence.

Plaintiff also contends that defendants' machine contributorily infringes plaintiff's patent because after defendants' machine has been in operation for a period of time the tapered extrusion holes become worn and their form changes from a hole tapered throughout its length to one tapered at its inlet and cylindrical at its outlet. In view of the finding of infringement by equivalency of claims one through four, it is not necessary to this memorandum to consider the question of contributory infringement.

Claim five of plaintiff's patent is in most respects similar to claims one through four, however, in claim five the extrusion holes are described as having ". . . an inlet portion tapering inwardly and an elongated portion connected to said tapered portion and extending through the plate to the outside surface thereof, . . ." This description differs from that set out in claims one through four which describes the extrusion holes as having ". . . an inlet portion tapering inwardly and a cylindrical portion connected to said tapered portion and extending through the plate to the outside surface thereof. . . ." It is the substitution of an elongate portion for the cylindrical portion of claims one through four which forms the basis of plaintiff's claim of direct infringement of claim five. Defendants' headplates all utilize an extrusion hole which is tapered from the inlet portion all of the way through the plate. Defendants' position is that this use of an extrusion hole which is tapered throughout its length is sufficient to prevent defendants' machine from infringing claim five of plaintiff's patent. The Court takes a contrary view. An extrusion hole which is tapered through its entire length, by necessity must have a tapered inlet portion and an elongate portion. The entire length of the hole cannot be the inlet. This tapered inlet portion and

elongate portion are exactly what is described in claim five of plaintiff's patent, and therefore defendants' food processing machine directly infringes claim five of the patent in suit. Even if defendants' machine did not directly infringe the patent, it is clear that the machine uses substantially the same process as that claimed in the patent, produces the same product in substantially the same manner and that it, therefore, infringes claim five by equivalence.

Having determined, assuming that the patent is valid, that defendants' machine infringes all five claims of the patent in suit, the remaining issue is that of the validity of the patent. On the issue of validity the defendants bear the burden of showing that the patent is invalid and must overcome the presumption of validity which attaches to the issuance of a patent. *Mumm* v. *Decker & Sons*, 301 U.S. 168, 171 (1937). Defendants advance several reasons in support of the contention that the patent is invalid. The first is that the language of the claims and of the specification is so indefinite that the metes and bounds of the claims cannot be determined, and the language of the specification is not sufficient to meet the requirements of § 112, Title 35, U.S.C. The Court is of the opinion that the language of the patent is sufficient to meet the requirement of § 112, and that the claims are set out in a manner which distinctly claim the subject matter of the invention.

Although the language used to describe the headplate in plaintiff's machine speaks of a headplate with substantial thickness and in that regard is indefinite, that language is qualified by the statement that the thickness of the plate should be greater than the largest diameter of the largest extrusion hole. Further, it is set out that

the total cross sectional area of the extrusion holes must be less than the cross sectional area of the bore in which the screw carrying the helical ridge rotates. The language of the patent while not set out with mathematical precision, does, in the estimation of this Court, set out the boundaries of the invention sufficiently to enable one skilled in the art to make and use it. As was stated in *General Electric Co.* v. *Wabash Corp.*, 304 U.S. 364, 369 (1938) "The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public." The Court is of the opinion that the patent in suit meets those standards and the standards of § 112, Title 35, U.S.C. and is therefore valid against a claim of insufficient description.

Defendants also contend that the patent involves only an old combination of components used in an old manner and is therefore not an invention, and that the use of a single headplate was obvious to one skilled in the art. The Court is in partial agreement with this in that all of the components of plaintiff's machine are components which were present in prior patented food processing machines with the exception of the single stage single headplate. The single stage single headplate used in plaintiff's machine takes the place of the multiple headplate arrangement used in earlier machines, and substantially simplifies the operation and cleaning of the food processing machine. Plaintiff's single headplate machine performs in one operation the extrusion and puffing which was originally done in two stages by a process of extruding the material and allowing it to expand slightly, and then re-extruding it through a second plate and allowing it to fully expand or puff.

It is a natural tendency in dealing with patents to substitute hindsight for foresight and by looking at the status of the invention at present determine that the invention is not invention, but is merely a use which was forecast by the prior art. This, to the Court's mind, is one of the reasons patents are presumed to be valid, and why doubts are resolved in favor of invention. While it might seem that the use of a single headplate would be obvious from the prior art, from the evidence adduced at the trial the Court is convinced that this was not the case, and that the employment of a single stage single headplate in a food processing machine constituted invention of that machine. Many inventions, in retrospect, appear obvious to those skilled and even those unskilled in the art, but were not actually obvious as inventions or novel improvements of a patentable type at the time of their conception, because if such were the case, a person could reasonably expect that such inventions would have been made or developed long before the patents were applied for and issued. In arriving at a decision of whether or not a particular item meets the test of invention, the Court must, within certain objective limits, decide the question subjectively, and as previously stated, the Court resolved the question in this case in favor of invention.

The Court is further of the opinion that the utilization of a single stage single headplate in plaintiff's machine embodies a new mode of operation, and whether the single headplate be deemed an omission of parts, a substitution or a combination, it is an invention. While it is true that the omission of a part, or the combination of old parts or the substitution of parts does not normally constitute invention, it is also clear that where the substitution or combination effects a useful change in the operation of the machine, then that substitution or combination is

patentable as an invention. *Enterprise Mfg. Co.* v. *Sargent*, 28 Fed. 185 (C.C.E.D. Pa. 1886); *Lawther* v. *Hamilton*, 124 U.S. 1 (1887); *Keystone Mfg. Co.* v. *Adams*, 151 U.S. 142 (1894); *Universal Incorporated* v. *Kay Mfg. Co.*, 301 F.2d 140 (4th Cir. 1962); *Eibel Process Co.* v. *Minnesota & Ontario Paper Co.*, 261 U.S. 45 (1923).

Defendants, in addition to the aforementioned grounds, advance the contentions that the patent in suit is invalid for the reasons that the subject matter of the patent was dedicated to the public, the machine in question was in public use more than one year prior to the date of the application for letters patent, and that new matter was inserted in the claims as a material limitation two years after the application was filed. It is clear from the evidence that the claims contained in the present patent are narrower than those in the claims disallowed and that they are therefore valid. The rejection of the original broader claims in favor of the narrower terms of the claims of the patent does not operate to dedicate the subject matter of the narrower claims to the public. It is not clear to the Court how the machine in question was allegedly put into public use more than one year prior to the application for letters patent nor has it been made apparent to the Court that new matter was inserted in the claims as a material limitation which would invalidate the patent. The Court is, therefore, of the opinion that the defendants have failed to sustain their burden of proof and that the presumption of validity of the patent has not been overcome.

From the record, the briefs, and the evidence before the Court, the Court makes the following findings of fact and conclusions of law.

FINDINGS OF FACT AND CONCLUSIONS OF LAW

The Court finds:

1. This Court has jurisdiction over the subject matter of this action and the parties thereto.

2. Patent number 2,842,072 and the claims stated therein are valid.

3. Plaintiff's single stage single headplate food processing machine was far superior to the prior multiple stage multiple headplate food processing machines, and the machine which is the subject of patent # 2,842,072 employs a new mode of operation in the manufacture of corn collets.

4. The use of a single stage single headplate in a machine used for the production of corn collets constitutes invention.

5. Prior to the time plaintiff designed his single stage single headplate machine other attempts had been made to use a single headplate machine, but such attempts had been unsuccessful.

6. The machine covered by patent # 2,842,072 has enjoyed commercial success and plaintiff now has some 18 machines placed under leasing agreements.

7. Defendant Edwin F. Kelley, prior to 1960, observed the Graves single stage single headplate machine in operation at the Clover Club Foods, Inc. plant in Kaysville, Utah, and also observed the Graves single stage single headplate machine in operation at the Filler Products Co. plant in Atlanta, Georgia.

8. Defendants Manley, Inc., Kell-Dot Industries, Inc., and Edwin F. Kelley have through their joint efforts designed, manufactured, sold, and used, food processing machines which infringe plaintiff's patent # 2,842,072.

9. The machines of the defendants perform the same operation and achieve the same result in substantially the same way as the machine described in patent # 2,842,072 claims one through four, and therefore the machines of defendants infringe claims one through four of patent # 2,842,072 by equivalency.

10. Claim five of patent # 2,842,072 is directly infringed by defendants' machines since those machines employ a single headplate using an extrusion hole which has a tapered inlet portion and an elongate portion.

11. All of the defendants to this action are infringers of patent # 2,842,072 and are jointly and severally liable for the damages resulting from the infringement and for the costs of this suit.

12. Plaintiff is entitled to a permanent injunction against defendants for infringement of patent # 2,842,072 and to an accounting for compensatory damages, but is not entitled to an award of attorneys' fees.

Judgment accordingly on the issue of validity and infringement, jurisdiction retained on issue of damages. Judgment will be settled before the Clerk on the usual notice.

/s/ Floyd R. Ginn
Judge

Kansas City, Missouri,
May 11, 1964

APPENDIX B

United States Court of Appeals

FOR THE EIGHTH CIRCUIT

No. 17,800

Kell-Dot Industries, Inc., et al, Appellants, v. George O. Graves, d/b/a Michiana Mills, Appellee.	Appeal from the United States District Court for the Western District of Missouri.

[May 18, 1966.]

Before Vogel, Ridge* and Mehaffy, Circuit Judges.

Mehaffy, Circuit Judge.

This appeal involves the validity of a patent issued upon a "food processing machine" and its alleged infringement.

George O. Graves, d/b/a Michiana Mills, inventor and owner of the patent in suit, brought this action for infringement against Kell-Dot Industries, Inc., Edwin F.

*Judge Ridge, while a member of the panel before whom this case was argued, did not, by reason of a temporary disability, participate in the final determination of the case or the writing of the opinion.

Kelley, and Manley, Inc. Defendants denied liability and, by affirmative defense, pleaded invalidity of the patent. The District Court, in a published opinion, *Graves* v. *Kell-Dot Industries, Inc.*, 229 F.Supp. 143 (W.D. Mo. 1964), ruled the patent valid and infringed.

Based primarily on the recent teachings of the Supreme Court in *Graham* v. *John Deere Co.*, . . . U.S. . . . (1966), we conclude that the patent is invalid and, therefore, reverse.

The Patent in Suit

The Graves patent in suit, No. 2,842,072, was issued July 8, 1958, upon application filed March 21, 1956. The patented device is a food processing machine for producing and extruding from corn meal a puffed edible product known in the trade as "collets." Meal is prebaked to eliminate the moisture content and then extruded through a head plate where the cooler atmospheric temperature causes it to pop or puff. A knife attachment cuts the material to the desired length. The raw "collets" are then further baked, salted, flavored, and packaged and sold under various trade names such as "Corn Puffs," "Korn Kurls," and "Jacks." The District Court aptly described the machine:

> "The machine consists essentially of a housing with a bore therein, a rotatable member within the bore with a helical ridge on the periphery, a single extrusion die plate with a plurality of extrusion holes therein, each of the holes having a conical inlet connected to a cylindrical or elongate portion extending through the die plate, an annular flange on the periphery of the die plate with holes therein for securing the die plate to the housing, and a knife intermittently passing the outlet ends of the extrusion holes for cutting the extruded material in sections."

In 1948, plaintiff was furnished drawings of the Schwebke machine, which he identified as Patent No. 2,350,643, dated June, 1944, and engaged by his brother and Darwin F. Rosebrook to design a "collet" machine.[1] His design contained multiple extrusion or head plates and was patented No. 2,705,927 on April 12, 1955. It is referred to hereafter as the "G & R patent."

In 1948, plaintiff associated in business with his brother and Rosebrook, owners of the G & R patent, but withdrew in 1952 following a dispute over royalties. Plaintiff took a G & R machine for his own use under what he now asserts to have been an oral agreement with his brother and Rosebrook.

Following the common disaster death of plaintiff's brother and Rosebrook in 1953 and difficulties with the widows who had inherited the G & R patent, plaintiff modified his machine from a two-stage dual head plate to a two-stage single head plate arrangement. Early in 1956 the machine was again changed to a single stage, single head plate device and patented by plaintiff. It is upon this patent that the case at bar issued.

Machines embodying plaintiff's patent have been in commercial operation since 1956. They are constructed, sold and leased by plaintiff who at trial date had eighteen out on lease agreements. There are five claims upon which the patent in suit was issued.[2]

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1. Although plaintiff verified use of the Schwebke machine, he identified it as Patent No. 2,350,643 dated June 1944 which is, we think, a mistake. We note the discrepancy as a mere oversight.

2. "1. In a machine for extruding and puffing cereal meal: a housing having a bore therein, a rotatable member in said bore having a helical ridge on the periphery thereof, an extrusion die

Decision of the District Court

The District Court found "invention" in the utilization of a single stage, single head plate in a food processing

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plate mounted on said housing across said bore and having a plurality of extrusion holes extending through the plate and communicating directly with the area in said bore occupied by the ridged periphery of said member, each of said holes having an inlet portion tapering inwardly and a cylindrical portion connected to said tapered portion and extending through the plate to the outside surface thereof, the total cross sectional area of said cylindrical portions being sufficiently less than the cross sectional area of said bore occupied by said helical ridge and the length of said cylindrical portions being sufficiently great to create sufficient friction and pressure to raise the temperature of the meal being fed therethrough to prebake said meal before it is expelled from said holes.

"2. In a machine for extruding and puffing cereal meal: a housing having a bore therein, a rotatable member in said bore having a helical ridge on the periphery thereof, an extrusion die plate mounted on said housing across said bore and having a plurality of extrusion holes extending through the plate and communicating directly with the area in said bore occupied by the ridged periphery of said member, each of said holes having an inlet portion tapering inwardly and a cylindrical portion connected to said tapered portion and extending through the plate to the outside surface thereof, the total cross sectional area of said cylindrical portions being sufficiently less than the cross sectional area of said bore occupied by said helical ridge and the length of said cylindrical portions being sufficiently great to create sufficient friction and pressure to raise the temperature of the meal being fed therethrough to prebake said meal before it is expelled from said holes, an annular flange on the periphery of said plate having a plurality of spaced holes therein, and means extending through said last mentioned holes for securing said plate to said housing.

"3. In a machine for extruding and puffing cereal meal: a housing having a bore therein, a rotatable member in said bore having a helical ridge on the periphery thereof, an extrusion die plate mounted on said housing across said bore and having a plurality of extrusion holes extending through the plate and communicating directly with the area in said bore occupied

machine because such usage embodied a new mode of operation. All components of plaintiff's machine were embodied in prior patented food processing machines with the exception of the single stage, single head plate.

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by the ridged periphery of said member, each of said holes having an inlet portion tapering inwardly and a cylindrical portion connected to said tapered portion and extending through the plate to the outside surface thereof, the total cross sectional area of said cylindrical portions being sufficiently less than the cross sectional area of said bore occupied by said helical ridge and the length of said cylindrical portions being sufficiently great to create sufficient friction and pressure to raise the temperature of the meal being fed therethrough to prebake said meal before it is expelled from said holes, and a means for engaging the marginal edge of said plate for removably securing said plate to said housing.

"4. In a machine for extruding and puffing cereal meal: a housing having a bore therein, a rotatable member in said bore having a helical ridge on the periphery thereof, an extrusion die plate mounted on said housing across said bore and having a plurality of extrusion holes extending through the plate and communicating directly with the area in said bore occupied by the ridged periphery of said member, each of said holes having an inlet portion tapering inwardly and a cylindrical portion connected to said tapered portion and extending through the plate to the outside surface thereof, the total cross sectional area of said cylindical portions being sufficiently less than the cross sectional area of said bore occupied by said helical ridge and the length of said cylindical portions being sufficiently great to create sufficient friction and pressure to raise the temperature of the meal being fed therethrough to prebake said meal before it is expelled from said holes, an annular flange on the periphery of said plate having a plurality of spaced holes therein, means extending through said last mentioned holes for securing said plate to said housing, and a knife means intermittently passing the outlet ends of said extrusion holes for cutting the extruded material into sections.

"5. In a machine for extruding and puffing cereal meal: a housing having a bore therein, a rotatable member in said bore having a helical ridge on the periphery thereof, an extrusion die plate mounted on said housing across said bore and

The accused device is essentially a copy of the patent in suit with only slight expected variations. The District Court held that the accused device infringed all five claims —infringement of Claims 1 through 4 by equivalency and infringement of Claim 5 directly.

Since we conclude invalidity of the patent in suit, there can be no infringement. *Caldwell* v. *Kirk Mfg. Co.*, 269 F.2d 506, 507 (8th Cir. 1959), cert. denied, 361 U.S. 915 (1959); *Johnson Fare Box Co.* v. *National Rejectors, Inc.*, 269 F.2d 348, 353 (8th Cir. 1959).

Invalidity of the Patent in Suit

With the death of his brother and Rosebrook, plaintiff admittedly anticipated a charge of infringement which he sought to avoid by altering the G & R patent. Plaintiff's only material change was the substitution of a single extrusion head plate for two such plates. Plaintiff candidly admitted that the product produced by the G & R machine was identical in quality and appearance to that produced by his machine. The shape and configuration of the holes, the screw, the feed hopper, the sleeve and other structures were the same.

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having a plurality of extrusion holes extending through the plate and communicating directly with the area in said bore occupied by the ridged periphery of said member, each of said holes having an inlet portion tapering inwardly and an elongated portion connected to said tapered portion and extending through the plate to the outside surface thereof, the total cross sectional area of said elongated portions being sufficiently less than the cross sectional area of said bore occupied by said helical ridge and the length of said elongated portions being sufficiently great to create sufficient friction and pressure to raise the temperature of the meal being fed therethrough to prebake said meal before it is expelled from said holes, and a knife means intermittently passing the outlet ends of said extrusion holes for cutting the extruded material into sections."

Plaintiff's motivation to avoid infringement has no bearing on the validity or lack thereof in his machine. What is important is that plaintiff's machine explicitly follows the prior art found in the G & R patent with the sole exception of utilization of a single extrusion head plate. Important also is that the prior art is replete with examples of extrusion machines using a single head plate. So many examples exist in the prior art that only a representative few were inserted in the record evidence. Examples are Tanzi Patent No. 1,228,495 (1922), machine for making macaroni; Sizer Patent No. 1,402,672 (1922), machine for making food cubes from meal for animals; Sizer Patent No. 1,773,552 (1930), machine for making pellets for poultry food; Schreiber Patent No. 2,583,600 (1952), machine for making food from combinations containing as much as 50% molasses and 50% dry ingredients.

The synthesis of the patent in suit is, therefore, an amalgam of known elements. Plaintiff's "union" of these old elements produced nothing new, surprising, or novel, perform no new function and add nothing to useful knowledge found or taught in the prior art. In *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147 (1950), the Supreme Court quoted with approval from its earlier opinion in *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U.S. 545, 549 (1938):

> "The mere aggregation of a number of old parts or elements which, in the aggregation; perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention." 340 U.S. at 151.

The Court, citing *Toledo Pressed Steel Co.* v. *Standard Parts, Inc.*, 307 U.S. 350 (1939) and *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84 (1941), continued: "The conjunction or concert of known elements

must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable." 340 U.S. at 152. See also *Selmix Dispensers, Inc.* v. *Multiplex Faucet Co.*, 277 F.2d 884 (8th Cir. 1960); *Caldwell* v. *Kirk Mfg Co., supra; Briggs & Stratton Corp.* v. *Clinton Machine Co.*, 247 F.2d 397 (8th Cir. 1957), cert. denied, 355 U.S. 914 (1958).

Plaintiff originally supported his application with eighteen claims. Upon rejection by the patent office, he attempted amendment of some but finally cancelled all of them and submitted, at the suggestion of the examiner, the claims heretofore set out in the margin which are the basis of the examiner's approval and which measure the grant of patent. A number of the rejected claims refer directly to utilization of single head plates but the five constituting the basis of plaintiff's patent do not.[3]

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3. The following are excerpts from three of plaintiff's eighteen amended claims which were withdrawn by him:

"2. A machine for producing collets from cereal, comprising a hopper for cereal, a chamber adapted to receive said cereal from said hopper, a source of water for said chamber, a means in said chamber for mixing said cereal and said water, a housing having a bore therein, a *one-piece*, one-stage plate secured to said housing across said bore and having a plurality of holes therethrough communicating with said bore and disposed in a circle in said plate adjacent the side wall of said bore. . . .

"3. A machine for producing collets from cereal, comprising a hopper for cereal, a chamber adapted to receive said cereal from said hopper, a source of water for said chamber, a means in said chamber for mixing said cereal and said water, a housing having a bore therein adapted to receive the cereal from said chamber, a *one-piece*, one-stage plate secured to said housing across said bore and having a plurality of holes therethrough communicating with said bore and disposed in a circle in said plate adjacent the side wall of said bore. . . .

"4. A machine for producing collets from cereal mixture, comprising a hopper for cereal, a housing having a bore therein

Nonetheless, plaintiff's patent must be sustained if at all upon the employment of the single head plate. We assume that stripped of its patentise language, the five claims primarily focus attention to the single head plate and do not understand the patent examiner's rejection of more specific claims for this element and final acquiescence when more obscure language was employed. The examiner must have been persuaded by the configuration of the single head plate, but it is admitted that the older machines prebaked the material and there is no novelty in the shape or configuration of the element. Plaintiff admitted that the holes in the head plate were used in 1952 and that the G & R machine prebaked the material before expulsion.

Plaintiff undertakes to bolster his position by extravagant claims of commercial success, improvement eliminating employment of skilled personnel and greater production speed. Indeed, some commercial success was enjoyed, but there is no evidence that it eliminated or impeded any competition. It may be slightly more economical because one head plate is less expensive than two, but it does not eliminate skilled employees. For example, an employee must clean the head plate holes to remove the adhesion of collected material. Cleaning is performed by simply punching the holes with a sharp pointed instrument such as a screw driver or ice pick. And, there is no evidence that the operation of any machines based on an old patent required additional skill in any phase of operation. Such argument, based as it is on plaintiff's testimony, loses per-

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adapted to receive cereal from said hopper, a *one-piece*, one-stage plate secured to said housing across said bore and having a plurality of *extrusion* holes therethrough and communicating with said bore and disposed in a circle in said plate adjacent the side wall of said bore. . . ." (Amendments in emphasis.)

suasiveness in light of the testimony of Mr. Guy Caldwell, who for years has manufactured a cheese stick product at locations in three states under the trade name of "Guy's Cheese Stix." Mr. Caldwell has used not only plaintiff's machine, but also one by the alleged infringers, and discarded the patent in suit five years before trial, replacing it with the G & R machine which made higher quality products faster.

Plaintiff also asserts that the substance of the question here is one of fact and that Fed. R. Civ. P. 52(a) requires our affirmance unless the findings are clearly erroneous. This same argument was made in *Great Atlantic & Pacific Tea Co., supra,* and the Supreme Court there rationalized that it was not setting aside a finding of fact as to invention, but merely correcting a defect in judgment as to the standard of invention as required by the statute, 35 U.S. C.A. §103, where a combination is made up entirely of old components. Mr. Justice Douglas in his concurring opinion stated, "The standard of patentability is a constitutional standard; and the question of validity of a patent is a question of law." 340 U.S. 147, 155. See also *Steffan* v. *Weber Heating & Sheet Metal Co.,* 237 F.2d 601, 602 (8th Cir. 1956).

We are not troubled by this issue because obviousness is apparent from plaintiff's own admissions coupled with the undisputed evidence of utilization of single head plates in many and varied extrusion machines found in the prior art.

Recent Teachings of the Supreme Court

On February 21, 1966, the Supreme Court expressed itself for the first time in fifteen years on patent validity in *Graham* v. *John Deere Co., supra.* Actually, two cases were involved and decided on the issue of statutory ob-

viousness. In the companion case, *Calmar, Inc.* v. *Cook Chemical Co.*, the Supreme Court reversed a holding of patent validity because it did not meet the statutory test, and found that the differences in the patent claims and the pertinent parts would have been obvious to a person reasonably skilled in that art. *Calmar* is strikingly similar to the case here.

The District Court opinion in this case was written prior to the Supreme Court's recent decisions and the writer of this opinion authored *Calmar* which was reversed.

In *Calmar*, it was admitted that the invention was a combination of old elements and here it cannot be questioned that all elements of the patent in suit are contained in the prior art. In *Calmar*, the industry faced extinction unless an integrated closure pump could be devised that could withstand shipping without leakage or breakage. In the instant case, there was no problem to be solved. In *Calmar*, there was a long-felt need for such a device, not only in the insecticide industry but also by manufacturers of other low viscous liquids. Many skilled people worked unsuccessfully for years to solve the Calmar problem, but in the instant case, so far as shown by this record, no one except plaintiff, motivated by his desire to avoid infringement, was even working on any change in the existing extrusion machines. There was nothing in the prior art in *Calmar* suggesting the combination of the old features, but in the instant case there are a number of extrusion machines utilizing the single, one stage head plate. Additionally, the patent in *Calmar* was a tremendous commercial success resulting in prompt sale of some fifteen million sprayers. The patent in *Calmar* was also adaptable to assembly line production and eliminated costly and time consuming production steps. Such results are not found

in the patent in suit. More important probably is that the device in *Calmar* produced a useful result new to the industry, whereas the patent in suit does not. It is quite obvious that a much stronger case was made for patent validity than in the instant case. Nonetheless, the Supreme Court was convinced that the patent in *Calmar* must fall when the proper interpretation is made of §103, since the differences in the claims of the Calmar patent and the pertinent prior art would have been obvious to a person reasonably skilled in that art.

We are convinced here that anyone skilled in the art with patent office references before him could have, without the exercise of any inventive faculty, combined old elements known to the art and made plaintiff's machine. Assuming that the patent in suit was an mprovement over the prior art, it still does not rise to the level of patentability.

Mr. Justice Clark, in the preface of his opinion in *Graham, supra,* called attention to the origin and history of the patent law and pointed out that, from its very inception, the granting of patents for small details or obvious improvements has been abhorred. We could not follow the guidance of the Supreme Court without ruling the invalidity of the patent in suit and would be compelled to do so anyway under the previous rulings of the Supreme Court as well as the decisions of this circuit.

The judgment of the District Court is reversed and it is ordered that the same be set aside in its entirety.

A true copy.
Attest:
Clerk, U. S. Court of Appeals, Eighth Circuit.

APPENDIX C

(Judgment)

United States Court of Appeals

FOR THE EIGHTH CIRCUIT.

No. 17,800. September Term, 1965.

Kell-Dot Industries, Inc., Edwin F. Kelley and Manley, Inc., Appellants, vs. George O. Graves d/b/a Michiana Mills.	Appeal from the United States District Court for the Western District of Missouri.

This cause came on to be heard on the record from the United States District Court for the Western District of Missouri, and was argued by counsel.

On Consideration Whereof, It is now here Ordered and Adjudged by this Court that the judgment of the said District Court, in this cause, be, and the same is hereby, reversed with costs; and that Kell-Dot Industries, Inc., Edwin F. Kelley and Manley, Inc., have and recover against George O. Graves d/b/a Michiana Mills, the sum of Three Thousand Six Hundred Twenty and 75/100 ($3620.75) Dollars for their costs in this behalf expended and have execution therefor.

And it is further Ordered by this Court that this cause be, and the same is hereby, remanded to the said District Court with directions to set aside its judgment in its entirety, in accordance with the Opinion of this Court this day filed herein.

May 18, 1966

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1966

No. 432

GEORGE O. GRAVES, d/b/a MICHIANA MILLS,
Petitioner,

vs.

KELL-DOT INDUSTRIES, INC., EDWIN F. KELLEY and MANLEY, INC.,
Respondents.

BRIEF FOR RESPONDENTS

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BRIEF FOR RESPONDENTS

This brief is filed on behalf of respondents in opposition to the Petition of George O. Graves, d/b/a Michiana Mills, for a writ of certiorari to the United States Court of Appeals for the Eighth Circuit to review the judgment of that court adverse to petitioner. The court below reversed the decision of the District Court which had held petitioner's patent valid and infringed by a food processing machine manufactured, used and sold by respondents.

OPINIONS BELOW

The opinion of the District Court, including the findings of fact and conclusions of law (App. A of Petition, a printer's error designating the trial judge as "Ginn" rather than "Gibson") is reported at 229 F. Supp. 143. The opinion of the Court of Appeals for the Eighth Circuit is set out at App. B of Petition.

JURISDICTION

The jurisdictional requisite is adequately stated in the Petition.

QUESTION PRESENTED

Whether or not the Court of Appeals for the Eighth Circuit, in holding the petitioner's patent invalid, followed and employed the applicable constitutional and statutory standards of patentability.

CONSTITUTIONAL PROVISIONS, STATUTES AND RULES INVOLVED

The applicable constitutional provision is Article I, Section 8, Clause 8. The applicable statutes (set out at p. 3 of the Petition) are 35 U.S.C., Sections 101 through 103 and 282. Rule 19 of the rules of this Court, 347 U.S. Appendix, 28 U.S.C.A. (Supp.) and Article I, Section 8, Clause 8 of the U. S. Constitution are also involved.

STATEMENT

In its review and reversal of the decision of the District Court, and in holding petitioner's patent invalid, the Appellate Court carefully considered the lower court's findings of fact and noted particularly that he had found the "invention" of the patent claims to be limited to the use of but a single headplate (Pet. A-15,

16). That finding (Pet. A-2, 10) resulted from the following representations made to the court at the trial by the petitioner:

> "The Court: Let me ask the plaintiff in this case, there isn't any contention is there that the device set up in the patent in question, -072, is different from the device set up in patent -927 in any element except the extrusion plate?
>
> "Mr. Hobbs: The crux of the invention is in the extrusion plate. Now, the extrusion plate, however, cannot be isolated from the rest of the structure. In other words, it forms an operative combination, and the claim so defines it so that the extrusion plate is in combination with the internal bore occupied by the helical ridge.
>
> "The Court: The Court appreciates the rest of it has to be there to complete the operation. But I mean there isn't any contention that the other elements that are present in -927 are not present in -072—
>
> "Mr. Hobbs: That is right.
>
> "The Court: —with the exception of the single extrusion plate?
>
> "Mr. Hobbs: You are correct on that, Your Honor.
>
> "Mr. Schmidt: I would like to ask whether or not this would be a stipulation, whether or not plaintiffs are contending that there is a difference in their invention in eliminating one more head plate from the -927 per se.
>
> "The Court: I took it that was their position.
>
> "Mr. Hobbs: That is the crux of the invention.
>
> "Mr. Schmidt: The crux of the invention? Instead of using two head plates, the use of one—

"Mr. Hobbs: In addition to the other elements in there. It is correct that the one head plate in combination with the other elements—

"The Court: That was the Court's understanding of the situation altogether.

"Mr. Schmidt: The use of one head plate instead of two?

"The Court: Yes." (R. 312, 313).*

Petitioner is named as the co-inventor in the G and R prior art patent No. 2,705,927 (R. 55) showing a collet extrusion machine having a number of headplates 74, 76, 78 with extrusion holes 82, 86, 88 (RX-48, 153, 154). In the commercialization of such machines (R. 161) petitioner testified that he used two headplates (R. 57, 62), his sketches thereof showing extrusion holes 82, 82A, 86, 86A (RX-49, 50). Petitioner conceded (R. 55-64) and the Appellate Court found the shape and configuration of the extrusion holes of the two prior art headplates, and others (RX-X; R. 287-289) to be the same as the holes 60, 62 of the single headplate 26 (RX-147) of petitioner's patent 2,842,072 in suit (Pet. A-17). Moreover, the Appellate Court made special note of petitioner's admission that "there is no novelty in the shape or configuration of the element", *i.e.*, "the configuration of the single head plate" (Pet. A-20).

The Trial Court ruled, therefore, "that all of the components of plaintiff's (petitioner's) machine are components which were present in prior patented food processing machines with the exception of the single stage single headplate" (Pet. A-7). The Appellate Court said

*The numerals "-072" above refer to petitioner's patent No. 2,842,072 in suit, and the numerals "-927" above refer to a prior art patent No. 2,705,927, called the "G and R patent."

that "what is important is that plaintiff's (petitioner's) machine explicitly follows the prior art found in the G & R patent with the sole exception of utilization of a single extrusion head plate" (Pet. A-18).

Petitioner admits the similarity of the product produced by the prior art with that produced by the machine of his patent in suit (Pet., p. 4) but fails to point out that in actuality the products were identical in nature and in quality, by petitioner's own admission (R. 183). The Appellate Court ruled accordingly (Pet. A-17).

Petitioner also made it clear at the trial that the "invention" of his patent in suit did not lie in the prebaking of the product. He admitted that in the prior art machines which he used commercially (a) "the temperature (was) sufficiently high to vaporize the moisture in the mixture"—(b) "to prebake the material"—(c) "sufficiently to render it relatively brittle" (R. 196). Such admissions—"that the older machines prebaked the material", and "that the holes in the head plate were used in 1952 and that the G & R machine prebaked the material before expulsion", were duly referred to in the decision of the Appellate Court (Pet. A-20).

Petitioner (the inventor himself) was convinced (and he so convinced the Trial Court), and it was his own personal belief that his "invention" was limited to the use of but a single headplate. The Trial Court found that such use "substantially simplifies the operation and cleaning of the food processing machine" (Pet. A-7). The Appellate Court also noted but rejected petitioner's attempt "to bolster his position by extravagant claims of commercial success, improvement eliminating employment of skilled personnel and greater production speed" (Pet. A-20).

ARGUMENT

1. Appellate Court fully considered and properly treated all portions of each claim of petitioner's patent.

Petitioner's proposition that the Appellate Court failed to consider the claims of his patent cannot operate as a reason for granting a writ of certiorari herein because it is contrary to fact. More specifically, petitioner argues that a certain italicized portion (Pet. 12) of the patent claims was disregarded. That portion of the claims refers to the extrusion holes of the headplate and speaks of their size, *i.e.*, area and length such as to "raise the temperature of the meal" and thereby "prebake" it.

As above pointed out, the Appellate Court said:

> "* * * it is admitted that the older machines prebaked the material and there is no novelty in the shape or configuration of the element. Plaintiff admitted that the holes in the head plate were used in 1952 and that the G & R machine prebaked the material before expulsion" (Pet. A-20).

We submit that this treatment by the court below of the subject matter of petitioner's proposition fully nullifies it as a reason for granting the writ. Moreover, it is clear that the Appellate Court read the record because no similar reference to petitioner's admissions was made by the Trial Court in his decision and findings (Pet. A1-A11). Rather than merely review the opinion of the District Court, the Court of Appeals went to the record itself and predicated its conclusions as to the italicized portion of the claims precisely upon the position of the inventor himself. Again, as above set forth, petitioner conceded that in the prior art machines:

(a) "the temperature (was) sufficiently high to vaporize the moisture in the mixture",

(b) "to prebake the material",

(c) "sufficiently to render it relatively brittle".

Now, it is also clear that petitioner was forced to make such admissions because he had previously conceded the identity of the single headplate with those he had previously used in the prior art G & R machines (R. 55-64). He had even sketched out the shape of the holes of the old plates (RX-49, 50) and demonstrated their identity with the headplate shown in his patent in suit. The Appellate Court had no choice other than to find that "plaintiff admitted the holes in the head plate were used in 1952 * * *" (Pet. A-20).

It follows then that the description in the patent claims of the single headplate is also a description of the prior art headplates. The italicized language of the patent claims, which describes the extrusion holes, also describes the holes of the prior art plates. The recitation therein that the holes "raise the temperature of the meal" is exactly what happened (as petitioner admitted) in the holes of the old plates. Raising the temperature of the meal high enough to "prebake the meal", as called for by the italicized portion of the patent claims, was admittedly done when the old plates were placed in use.

Furthermore, the presentation made by petitioner in an effort to support his contention that a writ of certiorari should be issued herein constitutes a complete change of position from the representations which he made to the lower courts. Having the burden of proving infringement, he was forced to have the patent claims interpreted as broadly as possible. In this he succeeded by convincing the Trial Court that his invention was

solely the substitution of one for a number of headplates.

On that basis then, any such machine using a single headplate would infringe regardless of the size, number or configuration of its extrusion holes, and the fact that in the accused machine the bore, the screw in the bore, the cut-off knife, and all other components were old and taken directly from the prior art would have no bearing. Even though prebaking and the end product were admittedly old, and in spite of the fact that the nature of the single headplate was not new, petitioner was able to persuade the Trial Court to find infringement solely because the accused machine used but a single headplate.

However, now, in his petition, this inventor speaks of "the unpatentable and broader concept of merely the use of a single headplate * * *" (Pet. 17), in contrast to his earlier position that "the crux of the invention is in the extrusion plate" (R. 312), which purposely left the Trial Court with the understanding that the invention was "the use of one head plate instead of two" (R. 313).

On the other hand, had petitioner taken the position at the trial which he now takes herein (that the mere use of a single headplate is an "unpatentable" concept) it would have been necessary for him to show the Trial Court where, in the claims of his patent, patentable limitations could be found. This he carefully avoided because a narrower interpretation of the claims would place the accused machine outside the realm of infringement.

Petitioner now says that "the basic distinctions over the prior art were set forth in the patent claims by the italicized part of the patent claims quoted hereinabove * * *" (Pet. 17). Had he, at the trial, attempted to differentiate the claims over the prior art to show them to be new

and valid on the basis of certain distinctions, those exact differences would have rendered the accused machine non-infringing.

As a matter of fact, the holes of the headplate of the accused machine are different from those of the headplate shown in the patent and different from petitioner's sketches of the G & R headplates. They have the shape and configuration of the holes of headplates of many other prior art patents. It was essential then to petitioner's charge of infringement that the Trial Court be persuaded to overlook those differences. Petitioner knew that he could not emphasize the italicized portion, or any other detail of his claims in an effort to show a differentiation therein over the prior art. To do so would have nullified his infringement position.

Instead, he took the only course available—convince the Trial Court that the details of the claims were old in the prior art—the invention was the use of a single headplate—the accused machine infringes because it uses a single headplate.

Now, in his petition, this inventor chooses to ignore his own admissions, overlook the fact that the Appellate Court considered his admissions, deny his previous argument that the "invention" is limited to a single headplate, and take a course of action which he dared not take in the lower courts when his infringement contention was at stake.

> "The owner of a patent cannot assert a broad construction of its claims in order to make out a case of infringement and then narrow them so as to avoid anticipation.—*Smith* v. *Hall*, Conn., 57 S. Ct. 711, 301 U.S. 216, 81 L. Ed. 1049— *International-Stacey Corporation* v. *U. S.*, 42 F. Supp. 384, 95 Ct. Cl. 357." 69 C.J.S., 679.

Petitioner's implication that the Appellate Court was unmindful of the fact that it must determine validity of the *claims of his patent* rather than the rejected, cancelled claims of his patent application is negated by the following statement from its decision:

> "Nonetheless, the Supreme Court was convinced that the patent in Calmar must fall when the proper interpretation is made of § 103, since *the differences in the claims of the Calmar (Cook) patent and the pertinent prior art* would have been obvious to a person reasonably skilled in that art." (Pet. A-23) (Emphasis added)

Petitioner's contention that the United States Court of Appeals for the Eighth Circuit disregarded a portion of the language of the patent claims is wholly without basis.

2. The Appellate Court gave full treatment to prima facie validity of petitioner's patent.

Petitioner calls attention to his observation that in the decision of the Appellate Court no direct reference is made, in so many words, to the statutory presumption of patent validity. 35 U.S.C. 282. Upon this observation petitioner bases his contention that the presumption was ignored by the court below. And upon such contention he petitions this Court to review the decision.

The fact that the Appellate Court did not expressly refer to the presumption does not, in any sense, infer that it did not receive proper consideration. One need look no further than the recent decisions of this Court in the Graham and Calmar cases (*Graham et al.* v. *John Deere Company of Kansas City*, 383 U.S. 1, and *Calmar, Inc.* v. *Cook Chemical Company*, 383 U.S. 1) for examples of a reviewing court applying the proper standards of

patentabiilty, giving due consideration to the presumption of validity set out in the statute, without mentioning the presumption in its opinions.

However, petitioner is wrong in charging the Appellate Court with ignoring 35 U.S.C. 282, treating the presumption as a nullity and failing to apply the law of the statute (Pet. 14-18). He is wrong in contending that "a thorough and careful reading of the decision of the Appellate Court fails to reveal any indication whatever that the statutory presumption of validity entered the mind of the Court with respect to the claims in issue in this case" (Pet. 16). Such reading was still not sufficiently "thorough and careful" because petitioner failed, in connection with this point, to call attention to the meaning and effect of the following language of the decision:

> "Nonetheless, plaintiff's patent must be sustained if at all upon the employment of the single head plate. We assume that stripped of its patentise language, the five claims primarily focus attention to the single head plate and do not understand the patent examiner's rejection of more specific claims for this element and final acquiescence when more obscure language was employed. The examiner must have been persuaded by the configuration of the single head plate, but it is admitted that the older machines prebaked the material and there is no novelty in the shape or configuration of the element. Plaintiff admitted that the holes in the head plate were used in 1952 and that the G & R machine prebaked the material before expulsion." (Pet. A-20).

Therefore, what the Appellate Court said, in effect, was that it recognized that the claims in issue had been deemed patentable in the first instance by the U. S. Patent Office. The Court was mindful of the fact that there must have been a reason for allowance and that it

had a duty to give due consideration to the decision of the patent examiner. So it raised the question of why the examiner did what he did and concluded that he "must have been persuaded" by certain factors.

The net result is a full recognition by the Court that it should not merely invalidate the claims on its own volition without first considering the presumption that the patent examiner was right in allowing the claims. Due thought and consideration was given to the file history of the patent application and the prosecution, which included reading and interpreting the allowed claims with reference to the rejected claims and the prior art precisely as is required by this Court (*Calmar, Inc.* v. *Cook Chemical Company*, 383 U.S. 1, 15 L. Ed.2d 545, 565 (1966).

The court below also recognized that the presumption is rebuttable and ruled against patentability of the allowed claims. It is clear from the language of the decision above quoted that the Court was mindful of the fact, while it is true that a patent is *prima facie* valid, the presumption of validity is greatly weakened when defenses relied upon were not known by the Patent Office. Such defenses referred to by the Court include petitioner's admissions that the shape and configuration of the holes had previously been used by him in prebaking (Pet. A-20).

The "statutory presumption of validity" did, therefore, enter "the mind of the Court"; the statute was not "ignored"; there is no "fundamental error" for failure "to apply the law"; and there was no "fundamental oversight by the Appellate Court in the application of the law" as contended by petitioner (Pet. 16, 17).

3. The Appellate Court correctly considered the necessity of non-obviousness as a statutory condition for patentability.

The importance which the Appellate Court attached to the question of obviousness is indicated by the fact that, under a separate section entitled "Recent Teachings of the Supreme Court", it discussed the matter at length (Pet. A-21-23). But petitioner contends that there was still a failure to follow or apply the formula of this Court. That "formula" as defined by petitioner is to determine obviousness in reference to the language of or the invention covered by the patent claims (Pet. A-3, 7).

The Appellate Court fully understood the formula of this Court. It said that in the Calmar case the patent was held invalid because "the differences in the claims of the Calmar (Cook) patent and the pertinent prior art would have been obvious to a person reasonably skilled in the art" (Pet. A-23).

It then proceeded to apply the "formula" in the following manner:

> "We are convinced here that anyone skilled in the art with patent office references before him could have, without the exercise of any inventive faculty, combined old elements known to the art and made plaintiff's machine. Assuming that the patent in suit was an improvement over the prior art, it still does not rise to the level of patentability.
>
> "Mr. Justice Clark, in the preface of his opinion in *Graham, supra,* called attention to the origin and history of the patent law and pointed out that, from its very inception, the granting of patents for small details or obvious improvements has been abhorred. We could not follow the guidance of the Supreme Court without ruling the invalidity of the patent in

suit and would be compelled to do so anyway under the previous rulings of the Supreme Court as well as the decisions of this circuit" (Pet. A-23).

This is, therefore, not a case which involves questions of either fact or of law needing review by this Court. Petitioner contributed nothing to the fund of human knowledge. His machine was almost entirely old. The product it produced was old. The production by preheating was old. Raising the temperature to cause preheating was old. The holes in the headplate were old.

The invention was the removal of one old headplate from an old machine and continuing to use the other old headplate. As pointed out by the Appellate Court, whereas the patentee had many factors in the Calmar case to raise serious doubts as to obviousness, this petitioner had none (Pet. A-22-A-23). The Appellate Court properly held the subject matter of the claims to be obvious in view of the prior art.

CONCLUSION

Rather than present any special or important questions which remain unsettled after this Court's recent decisions in the field of patent law, the Petition merely raises issues which were thoroughly considered by the Court of Appeals in light of those decisions.

It has raised no points about which the circuits are in conflict. It has pointed to no unsettled questions which need determination by this Court. All of petitioner's contentions received consideration below. The patent involved certainly has no great public importance. In short, the Petition totally fails to set forth any "special and important reasons" whatsoever for the grant of certiorari here.

The Petition for certiorari should be denied.

Respectfully submitted,

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